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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,240	01/19/2005	Iain Frank Fraser	II/2-2278/MA2223/PCT	8341

324 7590 03/13/2007  
CIBA SPECIALTY CHEMICALS CORPORATION  
PATENT DEPARTMENT  
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P O BOX 2005  
TARRYTOWN, NY 10591-9005

EXAMINER
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KLEMANSKI, HELENE G

ART UNIT	PAPER NUMBER
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1755

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/523,240		FRASER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Helene Klemanski		1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 4,6-9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-21 is/are allowed.
- 6) ☒ Claim(s) 4,6,8,9 and 11 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 4, 6-9, 11, 12, 14, 18 and 19 have been amended, claims 1-3, 5, 10 and 22-38 have been deleted and no new claims have been added. Hence, claims 4, 6-9 and 11-21 are pending in the application.
2. The objection to the claims as set forth in the previous Office Action dated October 12, 2006 has been overcome by applicant's amendments and is now withdrawn.
3. Upon further consideration of the De Feo et al. (US 4,306,875) reference, the indicated allowability of claim 4 set forth in the previous Office Action dated October 12, 2006 is withdrawn. A new rejection over De Feo et al. is set forth below. A new rejection over the previously cited Ito et al. (US 5,698,490) reference is also set forth below.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

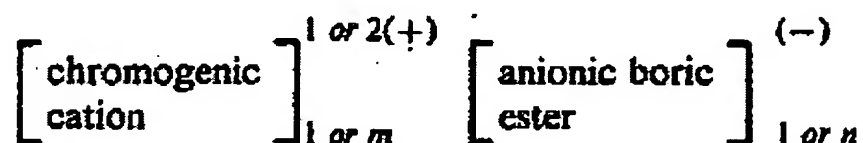
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

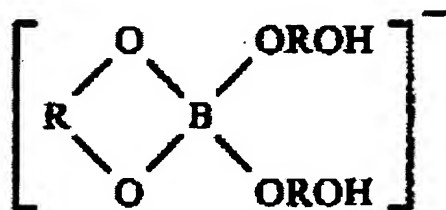
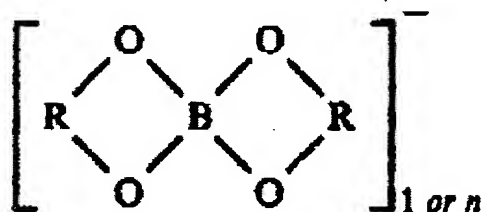
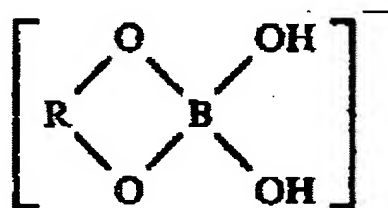
5. Claims 4, 6, 8, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by De Feo et al. (US 4,306,875).

Art Unit: 1755

De Feo et al. teach water-insoluble salts of basic dyes with good solubility in organic solvents comprising a basic dye of the formula



wherein the chromogenic cation is a residue of a basic dye such as Basic Yellow 29 (i.e. cationic dye of the formula as claimed by applicants; see STN Reg File printout, copy provided)) and the anionic boric acid ester is represented by the formula



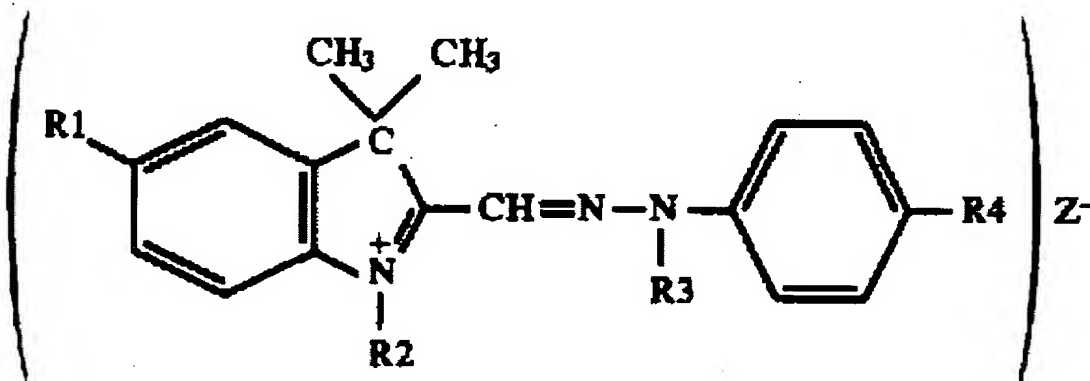
wherein R is the residue of an aliphatic alpha, beta-diol or of an aromatic orthodiol, which can be further substituted, or the residue of an aliphatic alpha-hydroxy-carboxylic acid or of an aromatic ortho-hydroxy-carboxylic acid which can be further substituted

Art Unit: 1755

(i.e. organic anion). De Feo et al. further teaches that the above water-insoluble dyes are useful in printing lacquers and ink compositions such as solvent and water flexographic inks, off-set and rotogravure printing inks and inks for ball point pens and inking pads. See col. 1, lines 53-55, col. 2, lines 18-55, col. 3, line 50 – col. 4, line 6, col. 5, lines 40-45, col. 7, lines 16-20, examples 7 and 22 and claims 1-4. The water-insoluble salts of basic dyes and ink compositions containing the water-insoluble salts of the basic dyes as taught by De Feo et al. appear to anticipate the present claims.

6. Claims 4, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al. (US 5,698,490).

Ito et al. teach a thermal transfer ribbon composed of a support and an ink layer (i.e. printing ink) formed thereon wherein the ink layer comprises a hydrophobic cationic dye of the formula



wherein R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub> and R<sub>4</sub> each independently represents H, an alkyl group or an alkoxy group and Z<sup>-</sup> represents a counterion such as Basic Yellow 28 and wherein the counterion has been replaced with an organic anion, solvents such as toluene and methyl ethyl ketone, binders such as polyvinylbutyral and pigments and/or dyes other.

Art Unit: 1755

than the cationic dye. See col. 2, lines 3-53, col. 3, line 26 – col. 4, line 19, col. 6, line 25 – col. 7, line 30, col. 7, line 63 – col. 8, line 2, examples 1-3 and claims 1, 2 and 6.

The ink layer as taught by Ito et al. appears to anticipate the present claims.

***Allowable Subject Matter***

7. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: None of the cited prior art teaches or fairly suggests that the resin acid is an organo-soluble acid selected from the group consisting of rosin acid, abietyl acid, colophony or derivatives thereof as claimed by applicants.

9. Claims 12-21 are allowed.

10. The following is an examiner's statement of reasons for allowance: None of the cited prior art teaches or fairly suggests a process for preparing a printing ink composition comprising mixing together at least one carbinol dye precursor of the formula as claimed by applicants an organic resin acid dissolved in an organic solvent and optionally a pigment as claimed by applicants.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***


The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1755

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Helene Klemanski  
Primary Examiner  
Art Unit 1755

  
HK

March 9, 2007